

REMARKS

I. Introduction

This paper is filed in response to the non-final Office Action mailed January 12, 2010.

Claims 3, 15, and 18 are amended by this paper solely for matters of form. Claims 3, 5-15, 18, and 20 remain pending.

Applicant submits that the pending claims are patentable in view of the references of record, as explained below. Accordingly, the Applicant respectfully requests that the U.S. Patent & Trademark Office (the “Office”) issue a Notice of Allowance without delay for the pending claims.

II. Claim Objections

The Office Action objected to Claims 3, 5 and 18 because of informalities for using the verb “being” that the Office contended is indefinite. Although the Applicant respectfully disagrees that the verb “being” is indefinite, each of claims 3, 5, and 18 is amended by this paper to remove the verb “being.” Withdrawal of the objections is requested.

III. Claims 3, 5, 7, 15, 18, and 20 are Patentable

The Office Action rejected claims 3, 5, 7, 15, 18, and 20 as obvious over a combination of teachings from U.S. Patent No. 6,539,387 to Oren, *et al.* and U.S.

Pub. No. 2001/0034814 to Rosenzweig. The Applicant respectfully traverses this rejection.

The Office bears the initial burden of providing a *prima facie* case for obviousness that is supported factually. MPEP § 2142. To establish *prima facie* obviousness, the Office Action must show, based on evidence of record, that the cited reference discloses or suggests each claimed element and that it would have been obvious to modify teachings in the reference to arrive at the claimed invention. See MPEP §§ 2141 and 2143; *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). This showing requires Examiners to determine whether there was an apparent reason to combine elements in references and to articulate that reason. See *KSR Int'l Co. v. Teleflex, Inc.* 550 U.S. at 418 (*citing In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

The Applicant submits that the Office failed to establish *prima facie* obviousness at least because (1) a combination of Oren and Rosenzweig, even if a reason had existed for combining teachings from these references, fails to disclose or suggest each claimed feature; and (2) no reason existed for combining teachings from Rosenzweig with those of Oren. Claims 3, 5, 7, 15, 18, and 20 are patentable for at least these reasons as explained below.

A. Oren and Rosenzweig fail to disclose or suggest the claims

Claim 3 requires the following:

- establishing a user-executable navigation link from at least one sub-portion of the database to a second sub-portion of the

database, the user-executable navigation link permitting a user to navigate from the at least one sub-portion to the second sub-portion, wherein the second sub-portion is non-sequential to the at least one sub-portion; and

- recording an address in the database of each sub-portion from which the user-executable navigation link is made to allow a user to return to the sub-portion from which the navigation link is made.

The user-executable navigation link permits a user to navigate from one sub-portion of the database to a second sub-portion that is non-sequential to the first sub-portion. For example, a user can digress from highly structured and linear sequential navigation links provided by the data structure and thereafter return to the sub-portion in the linear sequence from which the user digressed.

Claims 15 and 18 include similar requirements.

The Office did not contend that Oren disclosed these features; instead, the Office relied on the teachings from Rosenzweig in its rejections. See e.g. Office Action, pp. 4-5. Rosenzweig, however, fails to disclose or suggest these features.

Rosenzweig discloses a Web page 300 that has links 302 and 304 for accessing web page 310 and web page 330, respectively. See Rosenzweig, Fig. 3, ¶¶ [0046]-[0047] and [0050]-[0051]. As noted by the Office, Rosenzweig further discloses the following: "Web page 300 is the common link to all of the other links contained within web page 300. For example, web page 300 provides

access to the chain of links beginning with link 300 and the chain of links beginning with 304 regardless of whether or how those chains might subsequently intersect.” *Id.* at ¶ [0052].

The Office contended that the web page 300 in Rosenzweig is “a user-executable navigation link” that permits a user to navigate from a sub-portion to a second sub-portion that is non-sequential to the sub-portion. Even if web page 300 is a “navigation link” (which the Applicant does not concede), nothing in Rosenzweig teaches or suggests that this web page 300 can permit a user to navigate **from a sub-portion to a second sub-portion that is non-sequential to the sub-portion.** Instead, the web page 300 merely permits a user to navigate to the web page 310 or to the web page 330. See e.g. *id.*, at ¶ [0048].

That is, even assuming web page 310 and web page 330 are sub-ports (which the Applicant does not concede and herein expressly contests), the web page 300 does not permit a user to navigate from web page 310 to web page 330 or vice versa. Indeed, Rosenzweig clearly discloses that to navigate from web page 330 to web page 310, the user selects anchor (i.e. link) 332 that is on web page 330. See *id.* at Fig. 3, ¶ [0051]. The web page 300 is not involved in permitting user navigation from one web page to another. Rosenzweig explicitly states that “[a]fter perusing web pages 310 and 320, the user can return to web page 300 in order to follow another link [e.g. link 304] identified by the search results.” *Id.* at ¶ [0052]. Accordingly, web page 300 cannot be a user-executable navigation link as in the claims.

Moreover, nothing in Rosenzweig discloses or suggests that web page 310 and web page 330 are sub-portions of a portion, as in the claims. And, the Office made no attempt to identify any teaching of Rosenzweig that disclosed or suggested these features.

At least because Rosenzweig fails to disclose a user-executable navigation link and sub-portions as in the claims, the Office failed to establish *prima facie* obviousness of claims 3, 15, and 18, along with dependent claims 5, 7, and 20. Withdrawal of the rejection and allowance of these claims for at least these reasons is kindly requested.

B. No Reason to Combine the teachings from Rosenzweig with those of Oren

i. **No reason to combine was articulated in Office Action**

The Office stated that “[i]t would have been obvious to a person with ordinary skills in the art at the time of the invention to incorporate the teachings of Rosenzweig with the teachings of Oren for the purpose of utilizing hyperlinks to navigate between different documents or between different locations within a document ([0006] of Rosenzweig).” Office Action, p. 5 (emphasis in original).

This is not a reason for combining reference teachings. Instead, it states that it would have been obvious to practice the teachings of Rosenzweig, without any relationship as to whether anyone would have modified the teachings from Oren to do so. That is, establishing that one would have practiced Rosenzweig is not a reason why one would have modified the teachings of Oren to include

Rosenzweig. More particularly, the issue is not whether one of ordinary skill would have practiced reference teachings; the issue is whether one of ordinary skill would have had a reason to combine teachings from one reference with those of another.

Because the Office failed to articulate any reason why one would have combined reference teachings together, the Office failed to establish *prima facie* obviousness. For at least this reason, withdrawal of the rejection and allowance of the claims is kindly requested.

ii. The evidence points away from combining teachings

Furthermore, the evidence of record supports a conclusion there was no reason why one of ordinary skill in the art would have modified features in Oren with those from Rosenzweig. Specifically, the Applicant submits that Oren, when considered in its entirety as is required, teaches away from the modification proposed by the Office. See MPEP § 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983) (“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would teach away from the claimed invention.”).

Oren discloses in Figure 1 a “prior art” diagram where each circle 12 represents a document or page of information that includes links as shown by lines 14. Oren, Fig. 1, col. 1, lines 41-49. Oren further states that the diagram “loosely takes the form of a web, with hypertext links extending from nodes in an unorganized and unstructured manner.” *Id.* at col. 1, lines 49-52. One problem

with this system “is the tendency for users to feel lost after several hypertext jumps [and a]s a result, users are often required to backtrack through previously visited nodes or to refer to lists of previously visited sites to find their way.” *Id.* at col. 3, lines 17-22. Oren solves this problem, among other described problems, of this system using hypertext “in a structured, focused manner so that users can quickly find specific bits of information using a natural associative thinking process.” *Id.* at col. 3, lines 1-6.

Rosenzweig describes precisely the system with problems that Oren seeks to solve. For example, Fig. 3 in Rosenzweig “illustrates a web page and hyperlinks to other web resources” that is in “the form of a web, with hypertext links extending from nodes.” See Rosenzweig, ¶ [0019]; Oren, col. 1, lines 49-51.

No person of ordinary skill in the art would have modified Oren to include teachings from Rosenzweig because doing so would include the problems that Oren sought to solve. As a result, such combination would have rendered the invention in Oren unsatisfactory for its intended purpose of solving those problems. See *In re Gordon*, 733, F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01(V).

For at least these reasons, the Applicant submits that the Office failed to establish *prima facie* obviousness. Withdrawal of the rejection and allowance of these claims is kindly requested.

IV. Claims 6 and 14 are Patentable

The Office Action rejected claims 6 and 14 as obvious over a combination of Oren, Rosenzvieg, and U.S. Pub. No. 2001/0047358 to Flinn, *et al.* Each of claims 6 and 14 depend from and further limit claim 3. Reasons for allowing claim 3 are provided above. For at least those same reasons, the Applicant submits that claims 6 and 14 are also patentable. Withdrawal of the rejection and allowance of claims 6 and 14 is kindly requested.

V. Claims 8-10 are Patentable

The Office Action rejected claims 8-10 as obvious over a combination of Oren, Rosenzvieg, and U.S. Patent No. 6,714,215 to Flora, *et al.* Each of claims 8-10 ultimately depend from and further limit claim 3. Reasons for allowing claim 3 are provided above. For at least those same reasons, the Applicant submits that claims 8-10 are also patentable. Withdrawal of the rejection and allowance of claims 8-10 is kindly requested.

VI. Claim 11 is Patentable

The Office Action rejected claim 11 as obvious over a combination of **four different reference teachings**: Oren, Rosenzvieg, Flora, and Flinn. Claim 11 ultimately depends from and further limits claim 3. Reasons for allowance claim 3 are provided above. For at least those same reasons, the Applicant submits

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that claim 11 is also patentable. Withdrawal of the rejection and allowance of claim 11 is kindly requested.

VII. Claims 12-13 are Patentable

The Office Action rejected claims 12-13 as obvious over a combination of **four different reference teachings**: Oren, Rosenzweig, Flora, and U.S. Patent No. 5,761,436 to Nielsen. Each of claims 12-13 ultimately depend from and further limit claim 3. Reasons for allowing claim 3 are provided above. For at least those same reasons, the Applicant submits that claims 12-13 are also patentable. Withdrawal of the rejection and allowance of claims 12-13 is kindly requested.

CONCLUSION

The undersigned submits respectfully that all pending claims are in a condition for allowance. If any additional fees are due for this application, the fees may be charged to Deposit Account number 11-0855. If there are any matters that can be addressed by telephone, the Examiner is urged to contact the undersigned attorney at 404 745-2520.

Respectfully submitted,

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Date: April 6, 2010

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